

Patent Attorney Examiner Comments 2010

Paper A1

Candidates did generally not score well in this paper, so detailed comments have been provided.

Question 1:

Surprisingly poorly answered. Candidates typically did not clearly articulate the requirements for late entry into national phase and the need for evidence, or who has the right to file in New Zealand.

Question 2:

Most candidates recognised that there was a 6 month grace period to file an application following Gazetted Exhibition. But few mentioned that if there had been commercial use of the invention it would invalidate a later filed application. The question focussed on searching and many candidates did not fully consider the cost and delay that may be involved in conducting a search, or that a cheaper option might be to file a complete in the first instance to make use of IPONZ searching - complete could later be converted to a provisional, if appropriate.

Question 3:

Not well answered. Main options, to file a convention application or to file a national phase application. Where a convention application was recommended, noone suggested it claim priority from both the US and PCT applications. Convention application option preferable as results in early examination. IPONZ will not examine NP application until after 31 month date, unless specific grounds for expedited examination apply (good and substantial reasons - Reg 38(b)).

Question 4:

Very poorly answered. Many candidates failed to outline the tests for assessing novelty and obviousness. The question said that the client had an NZ patent, yet many candidates discussed options for amending during examination, filing divisional applications and the like. Many candidates did not recognise that unity of invention is not a ground on which a granted patent can be invalidated.

Question 5:

A: Poorly answered. The question outlined a "Dreyfus Situation". Candidates that recognised this scored passing marks.

B: Reasonably well answered with most candidates recognising the pros and cons of early acceptance and how one may delay acceptance.

Question 6:

A: Well answered with most candidates gaining a pass mark.

B: Only a handful of candidates recognised the fact scenario related to a case of joint tortfeasor.

C: Reasonably well answered with a number of candidates recognising possible actions under s21, s22, s41 and s42. However very few candidates suggested commercial option of negotiating a licence, or the possibility of applying for a declaration of on infringement. Some candidates suggested discontinuing activities or modifying so that there was clearly no infringement.

Question 7:

A: most candidates recognised that the use of Alex's clothes peg may be considered public use. However, many did not fully articulate the provisions of s60 of the Patents Act 1953, or fully discuss the issues to be considered.

B: Well answered by all candidates.

C: While the majority of candidates thought the claim was overly broad or vague, surprisingly few candidates identified it as a claim-by-result and then go on to discuss the law applicable to such claims.

Question 8:

A: Most candidates understood NRDC expanded on GEC's application (Vendible Product test). However, many candidates did not clearly articulate the meaning of "vendible" and "product" provided in NRDC or clearly articulate the implications of the expanded test (that a process is patentable whether or not it produces a physical product).

B. Most candidates understood that methods that are purely intellectual are not patentable. However, only some discussed that methods which may involve intellectual steps but also include physical steps, have a real world connection, produce a tangible result, and have a commercially useful effect may be patentable.

Question 9:

Most candidates recognised that Kelly could potentially oppose Sam's application on the ground of obtaining. Only some of the candidates discussed the possibility of post grant opposition or revocation. Few candidates considered that the invention may actually be owned by BC Enterprises if it was created by Kelly in the course of her duties at the company. None of the candidates expressly addressed standing to oppose/revoke. While a number of candidates suggested Kelly should file her own patent application, few noted that if her case was successful, s62 allows her to take the priority date of Sam's application.